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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/076,554

02/19/2002

Yumiko Seki

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07/05/2006

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EXAMINER

VIG, NARESH

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,554

Applicant(s)

SEKI ET AL.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in reference to response received 04 April 2006. Claims 1, 3 – 6 and 8 are pending for examination.

Response to Arguments

In response to applicant's argument that claimed invention includes a step of acquiring information on a worldwide standard that defines contents that should be described in the application, and, cited reference ZipForm does not disclose acquiring information on a worldwide standard, defining contents that should be described in the application.

Even though, ZipForm does not explicitly teaches to acquire information on a worldwide standard, ZipForm does teach to get information at jurisdictional level [ZipForm, page 22]. Applicant is claiming preparing set of documents as their invention. ZipForm also teaches to prepare set of documents.

In response to applicant's argument that cited reference ZipForm does not teach acquiring information on a worldwide standard, defining contents that should be described in the application.

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Applicant is arguing a limitation which is not claimed by the applicant their invention.

In response to applicant's argument that cited reference ZipForm does not teach acquiring information on a standard unique to each country that is defined in detail in conformity with the worldwide standard, and acquiring information regarding published applications and examinations unique to each country.

Applicant is claiming acquiring plurality of type of information as their invention. Acquiring of information has been responded to earlier. Cited Reference is teaches to acquire information from plurality of documents for plurality of jurisdiction [ZipForm, page 18, 22].

In response to applicant's argument that assertion that cited reference ZipForm teaches forms for South Dakota Area and Kokomo Area." First, South Dakota is a state and Kokomo is a city. These are not countries having a worldwide connotation as claimed.

However, applicant's invention is preparing documents for a country (which is a jurisdiction following its own requirements), whereas, cited reference ZipForm also teaches to prepare documents for plurality of Jurisdictions by meeting each jurisdictions own requirements. ZipForm is capable of preparing documents for plurality of countries to meet each country's own jurisdictional requirements.

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In response to applicant's argument that cited reference ZipForm does not teach the limitation assisting in the preparation of application documents based on the acquired information on the worldwide standard, information on the standard unique to each country, and the information on the published applications and examinations.

Applicant is separating the cited references in making this argument. In addition, applicant is arguing an amended limitation.

In response to applicant's argument that cited reference ZipForm does not teach preparing and converting the application documents for a certain country to comply with an application format or examination conditions in the country, such that none of the application documents include any item violating the examination criteria.

Applicant is separating the cited references in making this argument. In addition, applicant is arguing an amended limitation.

In response to applicant's argument that cited reference Gajraj does not relate to applications as in the present invention and further does not acquire information that defines contents to be described in an application, as in the present invention.

Applicant is separating the cited references in making this argument. In addition, applicant is arguing an amended limitation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3 – 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention merely recites merely acquiring information on a world-wide standard, acquiring information on a standard unique to each country, assisting in preparing application documents based on said acquired information, examining documents for compliance, preparing and translating documents for certain country does not only constitute an idea of how to prepare documents for a foreign country, and, does not produce concrete and tangible results. For example, examining of a document does not examine the document using the country for which the document is to be generated. For example, a user using the available information examines the document using the rules for China and produces the document for India.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2 – 5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

Getting information from user regarding contents for a document and country for which they want to prepare those documents.

After examination, if there is/are any violation(s), taking appropriate actions like system making corrections, outputting results for user to take appropriate actions.

Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

Means for getting information from user regarding contents for a document and country for which they want to prepare those documents.

After examination, if there is/are any violation(s), means for taking appropriate actions like system making corrections, outputting results for user to take appropriate actions.

Means for submitting documents to perform electronic application processing to enable the claimed method claims.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZipForm (document labeled as Information on ZipForm) in view of Gajraj US Publication 2002/0002566 and further in view of Broadbent et al. US Patent 6,904,412 hereinafter known as Broadbent.

Regarding claims 1 and 6, ZipForm teaches application preparation assisting method and system for assisting in preparing an application for making a document-based application [ZipForm page 11 – 13] to a public organization. ZipForm teaches:

Even though ZipForm does not explicitly teaches acquiring information on a world-wide standard which defines contents that should be described in said application. However, ZipForm does teach to get information at jurisdictional level [ZipForm page 22], and also ZipForm teaches Data Template [page 12]. In addition, Gajraj teaches A generic standard for DTDs is called Standard Generalised Markup Language (SGML) [Gajraj, 0004]. It is known to one of ordinary skill in the art that SGML is a device-independent, system-independent methods of representing texts in electronic form.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ZipForm as taught by Gajraj to have a standard format from which data is to be converted to a custom format. For example, it is known to one of ordinary skill in the art at the time the invention was made that Data Interchange Format (aka DIF) was one of the world standard format to transform data from first document (MS Excel) to second document (Lotus 123).

ZipForm in view of Gajraj teaches:

acquiring information on a standard unique to each country which is defined in detail in conformity to said world-wide standard (transforming a first document marked up according to a first document type definition, into a second document marked up according to a second document type definition) [Gajraj, 0014], and information on published applications and examinations unique to each country (teaches to acquire information from plurality of documents for plurality of jurisdiction) [ZipForm page 18, set for form for South Dakota Area and Kokomo Area]; and

ZipForm in view of Gajraj does not teach assisting to prepare application.

However, Broadbent teaches assisting to prepare application [Broadbent, Fig. 7-12, 33 and disclosure associated with Fig. 7-12, 33]

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ZipForm in view of Gajraj as taught by Broadbent to use the Federal, State, local and professional regulations and requirements and implementing instructions to generate a plurality of tasks which can be used to control and drive the process of handling an application.

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ZipForm in view of Gajraj and Broadbent teaches:

documents based on said acquired information on the world-wide standard, information on the standard unique to each country acquiring information on a standard unique to each country which is defined in detail in conformity to said world-wide standard (transforming a first document marked up according to a first document type definition, into a second document marked up according to a second document type definition) [Gajraj, 0014], and information on the application and examination [ZipForm in view of Gajraj, 0014].

ZipForm in view of Gajraj and Broadbent teaches:

examining application documents to check whether any of application documents include an item which violates examination criteria [Broadbent, abstract, Fig 7-12 and disclosure associated with Fig. 7-12].

preparing and converting the application documents for a certain country (jurisdiction) to comply with examination conditions in said country (jurisdiction) so that none of the documents include violation of examination criteria (Broadbent teaches to use Federal, State, local and professional regulations and requirements and implementing instructions to generate a plurality of tasks which can be used to control and drive the process of handling a mortgage loan application, another example of examining the documents to prevent violation of a authority like a jurisdiction) [Broadbent, abstract].

Regarding claims 3 and 8, ZipForm in view of Gajraj and Broadbent teaches capability for acquiring information on documents which have been applied in a certain country (ZipForm, area specific form), and information on documents which have accepted permission from said country as a result of examinations after application [ZipForm, reuse data, data transferred to other forms); and

assisting in preparing an application for another country with reference to said information on the documents [ZipForm, different area specific forms, page 18].

Regarding claim 4, ZipForm in view of Gajraj and Broadbent teaches electronically submitting the prepared application documents to perform electronic application processing.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over ZipForm (document labeled as Information on ZipForm) in view of Gajraj US Publication 2002/0002566 and further in view of Broadbent et al. US Patent 6,904,412 hereinafter known as Broadbent and Abbruzzese et al. US Patent 5557515 hereinafter known as Abbruzzese.

Regarding claim 5, ZipForm in view of Gajraj and Broadbent does not teach recording an entire manipulation procedure of an operator for preparing an application with the assistance of application preparation as log information so that the log

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information can be viewed at a later time. However, Abbruzzese teaches an electronic activity log function maintains a record of key activities involved in the processing of work items [abstract].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ZipForm in view of Gajraj and Broadbent as taught by Abbruzzese to automatically and securely maintain a record of the activities of all staff members in work processing.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

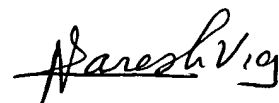
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig
Examiner
Art Unit 3629

June 25, 2006